



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
)	Application No: 10/635,873
Alice H. Howe)	
)	Art Unit 3711
TENNIS RACQUET EQUIPPED)	
WITH A TENNIS BALL RETRIEVER)	Examiner: Raleigh W. Chiu
)	
Attorney Docket No.: MPH 03-13)	Filing Date: 08/05/2003

Mail Stop AF
Commissioner for Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Accompanying this Certificate of Mailing are the following materials:

1. Transmittal letter;
2. Supplemental Response to Office Action;
3. Certificate of Mailing Date;
4. Self-addressed postcard for return acknowledging receipt of all of the above.

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United States Postal Service on October 12, 2005, in an envelope with sufficient postage as first class mail addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Signature

Sharyl L. Breu
Typed or printed name



AF
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Date: October 12, 2005

Dear Sir:

Transmitted herewith to the United States Patent and Trademark Office are the following:

1. Transmittal letter;
2. Supplemental Response to Office Action;
3. Certificate of Mailing Date;
4. Self-addressed postcard for return acknowledging receipt of all of the above.

Respectfully submitted,

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10/635,873

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This supplemental response supplements applicants responsive reply of October 11, 2005 to the final rejection of August 11, 2005.

SUPPLEMENTAL RESPONSE

There exists no citation of any prior art which teaches or suggests that the uniquely claimed embodiments of a pre-shrunk nylon monofilament hooked fastener material characterized by an average hook width of at least 1.00 mm, an average hook depth of at least 6.0 mm, an average monofilament diameter greater than 8.0 mil, and average hook height of at least 1.70 mm (as prescribed by claims 1 and 10) coupled with an additional prerequisite of method claim 10 requirement and dependent claim 4 as having “at least 250 hooks per square inch” and “of a spiral configuration arranged in repetitive rows” (claim 10) when attached to the convex curvature of a tennis racquet would exhibit an unexpected superiority in tangential hooking and lifting so as to allow the hooked material to retrieve all major brands of grounded tennis balls including balls weighted to more than three times the weight of an ordinary tennis ball (e.g. see examples and applicant’s affidavit in the parent application).

This represents a totally unexpected end result since all of the art of record clearly substantiates applicant's position that ordinary VELCRO type fasteners and all other ordinary hook fasteners of the hook and loop type heretofore used were notoriously recognized as ineffective or incapable of tangentially hooking and lifting a regular tennis ball.

Applicant has strenuously pointed out that the hook and loop fastener teaching relied upon in the 35USC103(a) rejection (such as those referred to as garment fasteners by Melbye) are especially designed solely for use as a hook and loop fastener combination for interfacially fastening and interlocking together. Attempts to use either fastener components without its paired fastening component (e.g. such the mating loop) results in a dramatic drop in fastening efficacy as well recorded by the futile efforts of the art of record.

The prior art has long recognized (more than a quarter century) the ineffectiveness of a monofilament nylon hook material to tangentially hook and lift a conventional grounded tennis ball. Feldi and U.S. Patent No. 5,056,786 to Bellettini went so far as to propose a redesign tennis ball cover so that cover becomes equipped with the mating loop component of the mating hook and loop fastening combination.

Other patentees have suggested that if you increase the over-all tennis ball retriever surface area, then the ineffective hook component density or hook surface area to provide a greater number of hooks to engage upon the wool pile fibers and thereby allow the ineffective hooks to become effective as a retriever. This is precisely what Urwin proposes by cupping the cupped retrieving hooked component about the tennis ball to increase the available number of hooks for engaging the tennis ball wool pile fiber.

Applicant's claims 1, 4 and 6-15 recite placement of the one-of-a-kind hooked material upon the shoulder of a tennis racquet. The hooked material thus rests in a convex position which

in effect minimizes the available hooks for tangentially contact and engagement onto the wool pile of a tennis ball. Even though Urwin does precisely the opposite by creating a cupped or concave surface area of contact so as to maximize hook contact with the tennis ball (while Feldi suggests changing the ball cover to looped fasteners), the Office Action completely disregards the essence of both Feldi and Urwin in the final rejection of applicant's claims 1, 4, and 6-15.

The essence of the Feldi and Urwin teachings become erroneously disregarded with an innocuous and meaningless disclosure in Smerdon that SCOTCHMATE SJ 3526 and SJ3527 fasteners have adhesive backings which possess good properties for use in adhering onto a water tube (such as subjected to periodic wetting by a cyclist drinking from it) so that when the mating fastening component is attached to a bicycle handlebar stem, the attached water tube is positioned in an available drinking position. The Smerdon patent does not remotely contemplate the use of the SJ3526 SCOTCHMATE hook material by itself. Smerdon neither describes nor places any significance upon the nature and character of the SJ3526 and SJ3527 hook and loop fasteners other than their intended and combined use as a hook and loop fastener combination to secure a watering tube to the handlebar stem of a bicycle.

Clearly, none of the patents have recognized the unique attributes of applicant's claimed invention as it relates to the retrieval of a grounded tennis ball with a tennis racquet. The adhesive backing teachings of Smerdon bears no consequence to the art recognized factual understanding that hook materials were notoriously known by themselves as being ineffective for use in retrieving tennis balls.

The enclosed U.S. Patent No. 6,652,397 B1 filed well after applicant's parent application and issuing while applicant's parent application was under final rejection and on appeal before the Board of Appeals creates a mystery as to why the Examining Attorney still fails to examine

applicant's invention upon the basis of what the prior art, as a whole, teaches. If applicant's invention were so obvious to the skilled artisan, why did the prior art persistently teach that hook materials, by themselves, would not work in a tangential contacting tennis ball system and clearly suggest alternative solutions to correct the inherent deficiencies of the hooked component of the hook and loop fastener. The summary of the background of the invention including Lamson's discussion about the host of patentees attempting to overcome the problem of the ineffectiveness of the hooked material upon tangential contact to retrieve a grounded tennis ball summarizes the state of the art at the time the Lamson patent was filed (i.e. May 17, 2002). Lamson's exhaustive comment upon the prior art confirms the position taken by the applicant in the parent and current prosecution of this application. The Lamson patent also names Raleigh W. Chiu as the Primary Examiner.

The Lamson patentee fully cognizant of the art recognized understanding that monofilament hooked materials are ineffective tangential ball retrievers, places the adhesive backing of one of the mating hook and loop components upon the shoulder of the tennis racquet and then engages the hook and loop fastener together leaving the sticky adhesive backing outwardly exposed so as to serve a sticky surface for picking up grounded tennis balls. Lamson reveals the prior arts total lack of confidence in the efficacy of the hooking element or component.

The Office Action concludes that the "applicant has recognized another advantage which would flow naturally following the suggestions of the prior art cannot be the basis of patentability when the difference would otherwise be obvious". Is it natural to undertake a completely contrary course of action from what the prior art (as a whole) fairly teaches and suggests and then to discover a new and unexpected result? The skilled artisan does not operate

in vacuum but is very knowledgeable about what the prior art teaches. If a ordinary artisan is desiring to practice a method for tangentially retrieving a grounded tennis ball, what purpose other than some abstract, theoretical and illogical thought would ever motivate or prompt the artisan to use a class of materials notoriously recognized to be ineffective for that purpose?

The Office Action relies upon applicant's own teachings as a template for finding unrelated and incongruent teachings which (as applied in the final rejection) remain in complete discord with remaining patents as cited and relied upon in the 35USC103(a) rejections. Since Smerdon or Feldi both suggest the normal and intended usage of both the hook and loop fastener combination together, what logic or rational would preclude such a combined use in the manner such as taught by Lamson? The final rejection appears to rest upon the theory that if you undertake a series of untaught steps contrary to the patent teachings of record, the skilled artisan would somehow mystically discover applicant's unique and unobvious invention.

The prior art as construed and applied against applicant's claims herein, remains out of step and out of reality with what the art, as a whole, teaches. The Office Action in this application still rests upon an impermissible untaught "factual" justification to overcome the shortcomings of the parent application appeal which likewise could not find any art of merit under 35USC103(a) to deny the patentability of applicant's claims.

Applicant respectfully submits that claims 1, 4 and 6-15 are allowable in form and define patentable subject matter over the art of record. The prior art as applied in the final rejection of applicant's claims herein fails to overcome the reasons for allowability as correctly held by the Board of Appeals in the parent applicant. Reconsideration and withdrawal of the final rejection and an early allowance of all the claims are respectfully requested.

Dated this 12th day of October, 2005.

Respectfully submitted,

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